REMARKS

This Application has been carefully reviewed in light of the Final Office Action mailed December 22, 2004. At the time of the Final Office Action, Claims 1-68 were pending. In the Office Action, the Examiner rejects Claims 1-68. Applicants amend Claims 1, 14-15, 24, 35, 44, 51, and 58. Applicants respectfully request reconsideration and favorable action in this case.

Section 102 Rejections

The Office Action rejects Claims 1, 14-15, 24, 35, 44, 51 and 58 under 35 U.S.C. §102(e) as being anticipated by U.S. Patent No. 6,301,258 issued to Katseff II et al. ("*Katseff II*"). Applicants respectfully traverse these rejections for the reasons stated below.

Independent Claim 1, as amended, recites as follows:

> A Voice over Internet Protocol (VoIP) telephony device for controlling the delivery of streaming media, comprising:
>
> a communication network interface operable to receive streaming media from a network device external to the VoIP telephony device, the streaming media comprising a voice message received by the communication network interface at a first delivery rate;
>
> a memory coupled to the communication network interface, the memory operable to store media received through the communication network interface; and
>
> a media rate controller coupled to the memory and the communication network interface, the controller operable to determine an adjustment to the first delivery rate and generate a command for transmission to the external network device, the command requesting a subsequent transmission of streaming media from the external network device to be delivered at an adjusted delivery rate based upon the adjustment to the first delivery rate.

"In order to establish a *prima facie* case of anticipation, all the elements of the claimed invention must be found within a single prior art reference. *Dewey & Almy Chemical Co. v. Mimex*, 124 F.2d 986, 52 U.S.P.Q. 138 (2d Cir. 1942). In addition, "[t]he identical invention must be shown in as complete detail as is contained in the . . . claims" and "[t]he elements must be arranged as required by the claim." *Richardson v. Suzuki Motor Co.*, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989); *In re Bond*, 15 U.S.P.Q.2d 1566 (Fed. Cir. 1990);

M.P.E.P. § 2131 (*emphasis added*). Applicants respectfully submit that *Katseff II* does not disclose, teach, or suggest each and every element of Applicants' Claim 1.

For example, Applicants respectfully submit that *Katseff II* does not disclose, teach, or suggest a media rate controller operable to 1) "determine an adjustment to the first delivery rate" and 2) "generate a command for transmission to the external network device." Rather, *Katseff II* discloses a system that includes a PC-based packet phone that utilizes buffering management. (Column 3, lines 5-7). "As audio data are received, the data are placed in the telephony input buffer." (Column 2, lines 15-16). "However, rather than wait until the buffer is full, the audio data are clocked, or played, out of the buffer as soon as the first data element arrives and at a rate slower than the normal play rate." (Column 2, lines 16-19). "Audio data continue to be played out at a slower than normal rate until the buffer fill level reaches a threshold. At that time, the play rate for sending data out of the telephony input buffer is adjusted to the normal play rate." (Column 2, lines 21-24). Thus, *Katseff II* is limited to a PC-based phone that merely adjusts, or changes, the play rate of data as it is removed from an internal buffer.

Specifically, *Katseff II* discloses that data that is received at the telephony device "is sent to telephony application 125 which directs the data into telephony buffer 129." (Column 4, lines 33-35). "In accordance with the present invention, buffer manager 150 operates to control telephony application 127 and telephony input buffer before the buffer fills up. Buffer manager 150 clocks the audio data out at a rate less than the normal rate (i.e., at less than the real-time rate) which allows telephony input buffer 129 to fill - thus utilizing the effectiveness of the buffer in reducing jitter." (Column 4, lines 45-52). In an example communication session between two end users, *Katseff II* provides that:

> When the second user (who is remote from the first user) initially begins to speak, telephony input buffer 129 [associated with the first end user] is typically empty . . . As the first audio data begins to arrive after the second user begins to speak, they are placed in telephony input buffer 129 as shown in block 201 of FIG. 2. Rather than waiting for the buffer to fill (either fully or to some predetermined level with the data, as soon as the first data element(s) are received they are played out of the buffer. Initially, the number of data elements in telephony input buffer 129 is

> small, so that the data cannot be played out at the normal rate; otherwise the buffer would not fill . . . In this way, the audio data will be processed and speech heard at speaker 170 at a time before buffer 129 would have filled without playing any data. At the same time, because the data are being played out at a rate slower than the rate at which they arrive in telephony input buffer 129, buffer 129 slowly begins to fill with data elements.

(Column 5, lines 16-65). Thus, the PC-based phone of *Katseff II* merely regulates the speed at which data within its own buffer is played to the end user. Accordingly, *Katseff II* does not disclose, teach, or suggest "a media rate controller . . . operable to determine an adjustment to the first delivery rate and generate a command for transmission to the external network device," as recited in Applicants' Claim 1.

As another example, Applicants respectfully submit that *Katseff II* does not disclose, teach, or suggest "the command requesting a subsequent transmission of streaming media from the external network device to be delivered at an adjusted delivery rate based upon the adjustment to the first delivery rate," as recited in Applicants' Claim 1. Applicants have established above that *Katseff II* does not disclose, teach, or suggest generating a command for transmission to an external network device. Accordingly, for reasons similar to those described above, *Katseff II* also cannot be said to disclose, teach, or suggest "the command requesting a subsequent transmission of streaming media from the external network device to be delivered at an adjusted delivery rate based upon the adjustment to the first delivery rate," as recited in Applicants' Claim 1.

The Examiner also relies on *Katseff II* to reject independent Claims 14-15, 24, 35, 44, 51, and 58. Applicants respectfully submit that *Katseff II* does not disclose, teach, or suggest each and every element of Applicants' independent Claims 14-15, 24, 35, 44, 51, and 58. For example, Claim 14 recites "a media rate controller . . . operable to . . . generate a command for transmission to the external network device . . . requesting a subsequent transmission of streaming media from the external network device to be delivered at an adjusted delivery rate based upon the adjustment to the first delivery rate." As another example, Claim 15 also recites "generating a command for transmission to the external network device, the command requesting a subsequent transmission of streaming media from the external network device to

be delivered at an adjusted delivery rate based upon the adjustment to the first delivery rate." As still another example, Claim 58 recites "a media output device . . . operable to . . . generate a command requesting a subsequent transmission of media to be delivered at an adjusted delivery rate based upon the adjustment to the first delivery rate" and "a media delivery system . . . operable to receive the command to adjust the first delivery rate and stream the subsequent transmission of media destined for the media output device to the communication network at the adjusted delivery rate." Thus, for reasons similar to those discussed above with regard to Claim 1, Applicants respectfully submit that *Katseff II* does not disclose, teach, or suggest each and every element set forth in Applicants' independent Claims 14-15, 24, 35, 44, 51, and 58.

For at least these reasons, Applicants respectfully request reconsideration and allowance of Claims 14-15, 24, 35, 44, 51, and 58, together with the claims that depend from Claims 14-15, 24, 35, 44, 51, and 58.

Section 103 Rejections

The Office Action rejects Claims 67 and 68 under 35 U.S.C. §103(a) as being unpatentable over *Katseff II* in view of U.S. Patent No. 5,822,537 issued to Katseff I et al. ("*Katseff I*").

First, Claims 67 and 68 depend from Claims 1 and 15, respectively, which Applicants have shown above to be allowable. Accordingly, dependent Claims 67 and 68 are allowable over the prior art at least because of their respective dependencies.

Second, Applicants respectfully contend that the *Katseff I-Katseff II* combination is an improper combination. To defeat a patent under 35 U.S.C. §103, the claimed *combination* must be obvious. *Kimberly-Clark Corp. v. Johnson & Johnson*, 745 F.2d 1437, 223 U.S.P.Q. 603 (Fed. Cir. 1984). "The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art suggests the desirability of the combination." M.P.E.P. § 2143.01. In the Office Action, the Examiner relies on *Katseff II* as the primary reference and *Katseff I* as the secondary reference. With regard to the rejection

of Claims 67 and 68, the Examiner characterizes *Katseff I* as "a related network communication system" and speculates that "it would have been obvious . . . to incorporate remote devices as taught in *Katseff I* into the communication system described in *Katseff II* because *Katseff II* operates with various network configurations and *Katseff I* suggests that optimization can be obtained by specifically adjusting remote rates." (Office Action, page 4). Applicants disagree, however, with the Examiner's characterization of *Katseff I* as a "related network communication system" and respectfully submit that one of ordinary skill in the art at the time of the invention would not have been motivated to make the proposed combination.

Applicants acknowledge that *Katseff I* and *Katseff II* share at least one common inventor and relate generally to communication over a data network. Applicants respectfully submit, however, that this is both the beginning and ending of any similarity between the two references. Whereas *Katseff II* relates to the field of packet telephony (Column 1, lines 10-12), *Katseff I* relates to the very different field of networked distribution of recorded multimedia presentations, such as seminars or conferences and supplemental materials, to computer systems. (Column 1, lines 12-17). In addition to being outside the field of technology of *Katseff II*, the computerized networked distribution system of *Katseff I* does not even remotely deal with the same types of problems encountered by packet telephony systems. For example, *Katseff II* explicitly states that the objective of the disclosed packet telephony system is to "[reduce] latency in packet telephony caused by anti-jitter buffering." (Column 2, lines 11-12). Thus, the solution proposed by *Katseff II* (controlling the delivery rate of the media stored in the internal telephony buffer) is designed to prevent the emptying of the internal buffer to prevent latency. Conversely, the objective of *Katseff I* is merely to allow for the remote access of digitized data using a computer terminal that neither experiences problems due to latency or jittering. Furthermore, there is no explicit or implicit reference in either reference which would suggest to one of ordinary skill to combine the networked distribution system of *Katseff I* with the packet telephony system of *Katseff II*. In this respect, Applicants respectfully submit that the references are non-analogous art and, because not related, an improper combination.

Applicants conclusion that *Katseff I* and *Katseff II* are non-analogous art is bolstered by the treatment of the patents by both the inventors and the Patent Office. Although including common inventors, the inventors themselves did not include a reference to *Katseff I* in the later filed *Katseff II*. Furthermore, the patents do not reference a common group art unit or any common search classes. As a result, one of ordinary skill in the art having either reference in hand would not have uncovered the other reference in a search. These facts provide further evidence that one of ordinary skill in the art at the time of Applicants' invention would have considered the references as relating to different fields of invention and would not have made the proposed combination.

For at least these reasons, Applicants respectfully submit that the proposed combination is improper and request reconsideration and allowance of Claims 67 and 68.

The Office Action also rejects Claims 2-13, 16-23, 25-34, 36-43, 45-50, 52-57 and 59-66 under U.S.C. §103(a) as being unpatentable over *Katseff II* in view of U.S. Patent No. 6,185,221 issued to Aybay ("*Aybay*"). Applicants respectfully traverse these rejections for the reasons stated below.

Claims 2-13, 16-23, 25-34, 36-43, 45-50, 52-57 and 59-66 depend from independent Claims 1, 15, 24, 35, 44, 51, and 58 respectively, which Applicants have shown above to be allowable. Accordingly, dependent Claims 2-13, 16-23, 25-34, 36-43, 45-50, 52-57 and 59-66 are allowable over the prior art at least because of their respective dependencies. Additionally, dependent Claims 2-13, 16-23, 25-34, 36-43, 45-50, 52-57 and 59-66 recite limitations that are not disclose, taught, or suggested by the proposed *Katseff II-Aybay* combination. Because Applicants have shown the independent claims to be allowable, however, Applicants have not provided detailed arguments with respect to each rejected dependent claim.

With respect to Claims 10-11, 23, 33, and 43, Applicants note the Examiner's taking of Official Notice and the Examiner's reference to the input device disclosed in U.S. Patent No. 6,374,225 issued to Hejna, Jr. ("*Hejna*"). Applicants respectfully traverses the rejection

of the claims on this basis. To the extent that the Examiner maintains this rejection based on "Official Notice" and *Hejna*, Applicants request that the Examiner provide a basis for a suggestion or motivation to combine the input device of *Hejna* with the packet telephony device of *Katseff II*.

With respect to Claims 13, Applicants respectfully submit that *Katseff II* does not disclose, teach, or suggest a media rate controller further operable to "determine whether the first delivery rate may be adjusted and to operate at only the first delivery rate if the first delivery rate may not be adjusted." To the contrary, these features are completely absent from the teachings of *Katseff II*. In the portion of the reference relied upon by the Examiner to reject Claim 13, *Katseff II* merely discloses that "initially, the number of data elements in telephony input buffer 129 is small, so that the data cannot be played out at the normal rate; otherwise the buffer would not fill" but that the slower rate used to play out the data elements "should be a rate at which the speech nonetheless is intelligible." (Column 5, lines 30-33 and 66-67). Thus, *Katseff II* merely discloses that the delivery rate must be slower than normal but not too slow. This is a very different concept from the media rate controller operable to "determine whether the first delivery rate may be adjusted and to operate at only the first delivery rate if the first delivery rate may not be adjusted" that is recited in Applicants' Claim 13.

For at least these reasons, Applicants respectfully request reconsideration and allowance of Claims 2-13, 16-23, 25-34, 36-43, 45-50, 52-57 and 59-66.

Conclusions

Applicants have made an earnest attempt to place this case in condition for allowance. For the foregoing reasons, and for other reasons clearly apparent, Applicants respectfully request full allowance of all pending Claims.

If the Examiner feels that a telephone conference or an interview would advance prosecution of this Application in any manner, the undersigned attorney for Applicants stands ready to conduct such a conference at the convenience of the Examiner.

Applicants believe no fees are currently due. However, should there be a fee discrepancy, the Commissioner is hereby authorized to charge any fees or credit any overpayments to Deposit Account No. 02-0384 of Baker Botts L.L.P.

Respectfully submitted,

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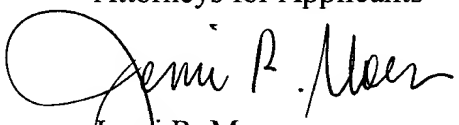
Attorneys for Applicants



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